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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,507	12/26/2000	Gary J. Dennis	BS99-202	9792

7590 12/27/2004
Withers & Keys, LLC
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EXAMINER

DIXON, THOMAS A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,507

Applicant(s)

DENNIS ET AL.

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 22 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 20, 21, 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 22 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The request filed on 7/19/04 for Continued Examination (RCE) based on parent Application No. 09/746,507 is acceptable and an RCE has been established. An action on the RCE follows.

2. Applicant's arguments regarding the combinability of Rutkowski et al and Ullrich are not convincing. The applicant argues that the references are not combinable because Ullrich allows the client to perform the orders without a technician.

The Rutkowski reference discloses that orders can be made by the client or technician, see column 5, lines 54-64, which appears to make the references combinable, Rutkowski and applicant's invention both appear to be saying that the presence of a technician in the subscriber's home can be used as a marketing opportunity and the technician can give immediate feedback concerning the order or transaction

It would be obvious that if Rutkowski's technician were at a client's location that either the client or the technician could use Ullrich's system, and are therefore combinable.

Drawings

3. Applicant is correct, the informal drawings are sufficient quality to permit examination, but are objected to as being informal.

Claim Interpretation

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4. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 1, including a computer, a communications network are disclosed in Rutkowski et al as described herein.

Further limitations of the system claims are seen to be non-functional descriptive material and intended use and do not distinguish the claimed apparatus from the prior art.

Method claims (and for the sake of argument corresponding to the system claims, with weight given to the non-functional system limitations) are rejected over Rutkowski and Ullrich, and further Peters et al (5,696,906) and FieldCentrix....

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-10, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Rutkowski et al (5,826,270).

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As per Claim 1.

Rutkowski et al ('270) discloses a customer service technician at a customer site electronically transacting business see column 5, lines 54-64, using:

a computer, see column 12, lines 19-42;

a communications networks, see column 7, lines 15-33 and column 12, lines 45-59.

The further limitations of this claim are seen to be non-functional descriptive material and intended use and do not distinguish the claimed apparatus from the prior art.

As per Claims 2-10, 22.

The limitations of these claims do not introduce new structure and are seen to be non-functional descriptive material and intended use and do not distinguish the claimed apparatus from the prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 7-13, 16-19, 22, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rutkowski et al (5,826,270) in view of Ullrich et al (5,583,937).

As per Claims 1 and 11.

Rutkowski et al ('270) discloses:

receiving information related to a problem experienced by a customer, see figure 3 (50);

deploying a technician requested by the customer in response to the information, wherein the technician is employed by a company which provides service to the customer, see column 7, lines 11-37;

initiating a communication with the company over a communications network by the technician by accessing a computer at the location requested by the customer when the technician receives a request from the customer for a transaction different from the problem, the communication including a submission of an identity of the customer, see column 1, lines 19-59, column 5, lines 57-61, column 9, lines 9-26, column 12, lines 26-59 and column 14, lines 25-43;

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sending, in response to the communication, customer information to the computer in use by the technician via a communications network from the company in response to the communication from the technician, see figure 1 (305, 345), column 5, lines 54-64, column 12, lines 26-59 and column 14, lines 25-43.

providing by the computer a list of one or more selected items, see figure 6 and column 16, lines 10-16 and column 14, lines 25-43;

receiving at the computer a selection from the list, see column 16, lines 10-16; communicating the received selection from the computer over the communications network, see column 16, lines 3-7

Rutkowski et al ('270) does not specifically disclose selecting by the computer one or more items corresponding to customer type from a set of items.

Ulrich et al ('937) teaches a computer generated menu of products available to subscribers, see column 4, line 51 – column 5, line 14, automatic display, column 3, lines 62-65 and further blockage of ordering and parental controls which is seen to be equivalent to applicant's customer type, column 6, lines 31-54 for the benefit of offering nearly on-demand programming to give the customer immediate feedback concerning the transaction.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Rutowski et al ('270) to display a list of products available automatically based on the customer type as taught by Ulrich to give the customer immediate feedback concerning the transaction.

As per Claims 2, 9, 10, and 18-19.

Rutkowski et al ('270) further discloses the company receives the request and automatically processes the request and modifies the customer's account, see column 5, lines 54-64.

As per Claims 3 and 12.

Rutkowski et al ('270) further discloses the communications network is wireless, see column 9, line 49 – column 10, line 6.

As per Claims 4 and 13.

Rutkowski et al ('270) further discloses the communications network is a wire line, see column 9, line 65 – column 10, line 6.

As per Claims 7 and 16.

Rutkowski et al ('270) further discloses the transaction includes the sale of a service, see column 9, lines 9-23.

As per Claims 8 and 17.

Rutkowski et al ('270) further discloses the transaction includes the sale of a product, see column 9, lines 9-23.

As per Claims 22, 25.

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Rutkowski et al ('270) further discloses the use of an Automatic Number Indicator interface which automatically generates information, see column 3, lines 62-65, which is seen to be self-populating of at least one field (customer's phone number, which is also in the data tables of column 14, lines 33-44) of the form; and

communicating the electronic sales form to the dispatch division, see column 5, lines 54-64.

7. Claims 5-7, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rutkowski et al (5,826,270) in view of Peters et al (5,696,906) and FieldCentrix....

As per Claim 5.

Rutkowski et al ('270) further discloses the system may convert the message into a format readable by other devices, see column 9, lines 27-36.

Rutkowski et al ('270) does not specifically disclose email sent to the technician's supervisor.

Peters et al ('906) discloses enabling ancillary services such as email services in a cable television system, see abstract and FieldCentrix teaches sending email to the Sales department for the benefit of providing an integrated computer system for account management.

The limitation of sending to the Supervisor is seen to be non-functional descriptive material which will not distinguish the invention from the prior art in terms of patentability, see *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 101 (Fed. Cir. 1983).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to email a message to the Sales department as taught by Peters et al ('906) and FieldCentrix or to any other recipient in the invention of Rutowski et al ('270) to produce an integrated computer system for account management.

As per Claims 6-7 and 14-15.

Rutkowski et al ('270) further discloses the system may convert the message into a format readable by other devices, see column 9, lines 27-36.

Rutkowski et al ('270) does not specifically disclose email.

Peters et al ('906) discloses enabling ancillary services such as email services in a cable television system, see abstract and FieldCentrix teaches sending email to the Sales department for the benefit of providing an integrated computer system for account management.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to email a message as taught by Peters et al ('906) and FieldCentrix in the invention of Rutowski et al ('270) to produce an integrated computer system for account management.

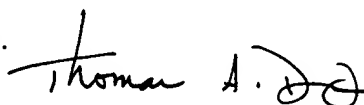
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Thomas A. Dixon", with a stylized flourish at the end.

Thomas A. Dixon
Primary Examiner
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December 04